REMARKS

Status of the Claims

Claims 1, 2, 4, 19 and 21 are pending in the present application. Claims 20 and 22-45 were previously canceled. Claims 3 and 5-18 are presently canceled. Claims 1, 2, 4, and 19 are amended to cancel subject matter that the Examiner alleges is not enabled. Claim 19 is also amended to incorporate a species that the Examiner indicates in the present Office Action is enabled. Support for the amendment to claim 19 is found on page 124, compound 2. Reconsideration is respectfully requested.

Substance of the Interview

Applicants would like to thank the Examiner for extending the courtesy of a telephone interview on March 9, 2009. Applicants' representative requested clarification of the term "-O-benzyl" on page 3 of the Office Action in view of the species listed under Example 1 on page 3 of the Office Action, which depicts "OBz" at position R^{21}. Applicants' representative noted that the term "Bz" is defined in the present application as "benzoyl" rather than "benzyl" on page 105 of the present application. The species depicted in the Office Action is also described in pending claim 19 and on page 105 of the present application as including the term "benzoyl." The Examiner agreed that "benzoyl" at positions R^{21} and R^7 is enabled, supported by the present application and is the R^{21} group referred to in the species depicted on page 3 of the present Office Action. In view of this discussion, the instant claims were amended with the term "benzoyl" rather than benzyl.

Improper Final Rejection

The final Office Action rejects claims 1-19 and 21 on new grounds. Specifically, the Examiner rejects the claims as allegedly lacking enablement based upon the "how to use" prong of 35 U.S.C. § 112, first paragraph, *see* Office Action, pages 3-4. In the previous rejection, the Examiner limited his comments to the "how to make" prong of 35 U.S.C. § 112, first paragraph, *see* Office Action issued December 17, 2007, pages 4-15.

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The only amendments to the claims in the response to the December 17, 2007, Office Action filed on June 17, 2008, were to cancel subject matter in order to expedite prosecution, which the Examiner alleged was not enabled, and to specify substituents, which were previously encompassed by the claimed compounds.

In the present Office Action, the Examiner rejects features of the claims, which were presented for examination in the preceding December 17, 2007, Office Action, as allegedly lacking enablement based upon the "how to use prong". Accordingly, the limitations presented previously should have been rejected for these reasons in an earlier Office Action, but were not.

Section 706.07(a) of the MPEP specifies the conditions under which the finality of a second or subsequent Office Action is proper. That is, under present practice, a second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement.

Applicants submit that because the features in the pending claims, which the Examiner alleges were not enabled based upon the "how to use" prong, were presented for examination in the preceding Office Action, the new ground of rejection of claim 1 made in the final Office Action cannot reasonably be said to be either necessitated by a claim amendment or an Information Disclosure Statement.

The conditions set forth in § 706.07(a) of the MPEP have not been satisfied. Accordingly, for that reason alone, the finality of the final Office Action should be withdrawn.

Issues Under 35 U.S.C. §112, First Paragraph

Claims 1-19 and 21 are rejected as allegedly lacking enablement, *see* Office Action, page 3. The Examiner states R^7 and R^{21} are enabled for -O-benzyl, OH, RC(=O), wherein R is piperazinyl, alkyl, -O-phenyl, -N-alkyl, -N-phenyl, but is not enabled for the list of chemical moieties or claimed substitutents, *see* Office Action, page 3. The Examiner further states that Applicants have only provided data for three species of compounds, which allegedly do not support the entire scope of R^7 and R^{21}, *see* Office Action, pages 3-4. As noted above the term "-

O-benzoyl" is the appropriate term in reference to the species depicted on page 3 at Example 1 of the present Office Action.

Claims 3 and 5-18 are canceled. Accordingly, the rejection is moot in regard to these claims.

In order to expedite prosecution, the claims are amended to specify that R^7 and R^{21} is –O-benzoyl, OH, or RC(=O)-O-, wherein R is piperazinyl, alkyl, -O-phenyl, -N-alkyl, or -N-phenyl as the Examiner suggests. Accordingly, the enablement rejection is overcome and Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the above Amendment and Remarks, Applicants believe the pending application is in condition for allowance.
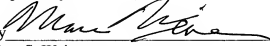
The conditions set forth in § 706.07(a) of the MPEP have not been satisfied. Accordingly, for that reason alone, the finality of the final Office Action should be withdrawn.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Linda T. Parker, Reg. No. 46,046, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: MAR 1 2 2009

Respectfully submitted,

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